

## **REMARKS**

This is intended to be a complete response to the Office Action mailed September 27, 2002 in which claims 1, 2, 4-10, 12-24, 31-33, 35 and 36 were rejected. Claim 13 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3-10, 31, and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Olney et al. (U.S. Patent No. 4,098,177). Claims 2, 8, 12-17, 19, 20, 22, 32, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weder et al. (U.S. Patent No. 5,314,398) in view of Landau (U.S. Patent No. 5,235,782). Amendments have been made to claim 13. No new matter has been introduced.

### **Applicant's Response to the Rejection of Claim 13**

#### **Under 35 U.S.C. § 112**

Claim 13 was rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In support thereof, the Examiner stated:

In claim 13, line 3, the phrase "floral disposed" is unclear.

Claim 13 has been amended to insert the word "grouping" to more clearly define that the upper portion of the preformed sleeve substantially surrounds

and encloses a floral grouping disposed within the pot. Thus, Applicant respectfully submits that the Examiner's rejection of claim 13 under 35 U.S.C. § 112, second paragraph, has been obviated.

Applicant's Response to Rejection of  
Claims 1, and 3-10, 31 and 35 Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner also rejected Applicant's claims 1, 3-10, 31, and 33 under 35 U.S.C. § 102(b) as being anticipated by Olney et al. (U.S. Patent No. 4, 098,177). In support of the rejection of claims 1, 3-10, 31, and 33, the Examiner stated:

As to Claim 1, Olney et al. disclose a preformed sleeve for covering a pot (Figs. 2 and 3) having an upper end, and outer peripheral surface comprising a base portion having an upper end (region around leadline of 112 in Fig. 3) and closed lower end (region around leadline 26a of Fig. 3; 108 of Fig.2), the base portion initially having a flat condition prior to being opened (defined as flattening cover on its side, not shown) having a tapered shape when in the flat condition; a skirt portion (region above leadline of 112 in Fig. 3) extending from the upper end of the base; and a plurality of unconnected, vertically oriented, accordion-like, expandable folds (114 of Figs. 2 and 3) in the base wherein when a pot is in the sleeve the folds expand so that the base substantially covers and surrounds the outer peripheral surface of the pot.

As to Claim 6, Olney et al. further disclose the material paper (col. 2 line 16).

As to Claim 7, Olney et al. further disclose accordion-type folds (Fig.3).

As to Claim 8, Olney et al. further disclose a portion serving as a handle (any part of region around leadline 114 in Fig. 3).

As to Claim 9, Olney et al. further disclose a drainage hole (110 of Fig. 2).

As to claim 10 Olney et al. further disclose the folds continuous between the base portion and the skirt portion.

As to claim 31, Olney et al. disclose a preformed sleeve for covering a pot (Figs. 2 and 3) having an upper end, lower end, and outer peripheral surface comprising a base portion having an upper end (region around leadline of 112 in Fig. 3) and closed lower end (region around leadline 26a of Fig. 3; 108 of Fig. 2), an interior space when open (see Fig. 2), the base portion initially having a flat condition prior to being opened (defined as flattening cover on its side, not shown) having a tapered shape when in the flat condition; and, a plurality of unconnected, vertically oriented, accordian-like, expandable folds (114 of Figs. 2 and 3) in the base.

As to Claim 33, Olney et al. further disclose accordian-type folds (Fig. 3).

Applicant respectfully traverses the rejection of pending claims 1, 3-10, 31 and 33 for the following reasons.

The present invention, as recited in independent claim 1 and the claims depending therefrom, is directed to a preformed sleeve for covering a pot. The preformed sleeve has a base portion having an upper end, a closed lower end, and an interior space when opened. The base portion initially has a flat condition prior to being opened for receiving the pot into the interior space. In the flat condition the base portion has a tapered shape. The preformed sleeve of claim 1 also has a skirt portion extending from the upper end of the base portion and a plurality of substantially unconnected, vertically oriented, expandable folds in the base portion. When the pot is disposed within the interior space of the base portion, the expandable folds in the base portion expand to cause the base portion to cover and surround the outer peripheral surface of the pot.

The present invention as recited in claim 31 and the claims depending therefrom is directed to a preformed sleeve for covering a pot having an upper end, a lower end, and an outer peripheral surface. The preformed sleeve includes a base portion having an upper end, a closed lower end, and an interior space when opened. The base portion is initially constructed to have a flat condition and has a flat condition prior to being opened for receiving the pot into the interior space. In the flat condition the base portion has a tapered shape. In addition, the preformed sleeve has a plurality of substantially unconnected, vertically oriented, expandable folds in the base portion.

Olney et al. discloses a filter cup for a percolator that is formed by the process of feeding a plurality of single sheets or webs of filter paper by roller means into a forming die 22 which is operated by the ram press 24. In the forming die the web 12 is cut and shaped into nested cups 26. (Col. 2, lines 65-69, Col. 3, lines 1-3). The filter cup has an annular bottom 108 with an axial opening 110 and upstanding sidewalls 112. The upstanding sidewalls 112 are provided with a plurality of flutes 114 about the periphery thereof. (Col. 4, lines 39-44). Olney et al. do not teach constructing the filter to have an initially flat condition.

Independent claim 1 and claims 3-10 depending therefrom and independent claim 31 and claim 33 depending therefrom contain the element of the base portion initially constructed to have a flat condition and having the

flat condition prior to being opened for receiving the pot into the interior space and having a tapered shape when in the flat condition. Olney et al. do not teach, disclose or even suggest such an element. Olney et al. disclose that the nested cups are in a non-flat, open position upon formation (FIG. 3, FIG. 6). The forming die presses the flat web into a filter cup having upstanding sidewalls. (Col. 4, line 41) The web is flat before it is formed into a filter cup, however, once formed, the filter cup is open and freestanding, not flat.

In fact, in the rejection the Examiner states that the element of a flat condition prior to use is "not shown." MPEP § 2131 states that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or [is] inherently described, in a single reference" (citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053). MPEP 2131 also quotes *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) in stating that "the identical invention must be shown in as complete detail as is contained in the...claim."

In the absence of each and every element in the cited reference, MPEP 2131.02 provides that elements not shown in the reference may be asserted as inherent. MPEP 2131.02 cites *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) in stating that such a "gap in the reference may be filled with recourse to extrinsic evidence" but "such evidence must make clear that the missing descriptive matter is

necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Applicant respectfully submits that the Examiner has not provided sufficient evidence as required by the MPEP to “make clear” that the filter of Olney et al. can be constructed to have an initially flat condition.

In fact, Olney et al. clearly shows that the filter cup is formed from the flat sheet into a preformed cup having an open condition and having an interior space. There is no evidence nor is it even shown that the filter of Olney et al. is made to have a flattened condition even after it is made into the filter, or that it is made to initially have a flattened condition.

Applicant respectfully requests, for the reasons set forth above, that the Examiner reconsider and withdraw the rejection of claims 1, 3-10, 31, and 33 under 35 U.S.C. § 102(b).

Applicant’s Response to Rejection of  
Claims 1, 3-7, 10, 21, 23, 24, 31, 33, and 35  
under 35 U.S.C. § 102(b)

In the Office Action, the Examiner also rejected Applicant’s claims 1, 3-7, 10, 21, 23, 24, 31, 33, and 35 under 35 U.S.C. § 102(b) as being anticipated by Weder et al. (U.S. Patent No. 5,314,398). In support of the rejection of claims 1, 3-10, 31, and 33, the Examiner stated:

As to Claim 1, Weder et al. disclose a preformed sleeve for covering a pot (Figs. 1-3) having an upper end, lower end, and outer peripheral surface comprising a base portion having an upper end (16 of Fig. 1) and closed lower end (18 of Fig. 1), the base portion initially having a flat condition prior to being opened (defined as flattening cover on its side, not shown) having a tapered shape when in the flat condition; a skirt portion (14 of Fig. 1) extending from the upper end of the base; and a plurality of unconnected, vertically oriented, accordion-like, expandable folds (30a-30q of Fig. 2; col. 3 lines 30-35) in the base wherein when a pot is in the sleeve the folds expand so that the base substantially covers and surrounds the outer peripheral surface of the pot. **(Note:** Examiner considers the priority of the present application to extend no farther than to US 6,151,830 (filed 22 April 1998) because in its immediate priority document, US 5,749,171, neither the specification or drawings disclose a sleeve with vertical oriented folds.)

As to Claim 21, Weder et al. disclose a preformed sleeve for covering a pot (Figs. 1-3) having an upper end, lower end, and outer peripheral surface comprising a base portion having an upper end (16 of Fig. 1) and closed lower end (18 of Fig. 1), the base portion initially having a flat condition prior to being opened (defined as flattening cover on its side, not shown) having a tapered shape when in the flat condition; a skirt portion (14 of Fig. 1) extending from the upper end of the base; and a plurality of unconnected, vertically oriented, accordion-like, expandable folds (30a-30q of Fig. 2; col. 3 lines 30-35) in the base wherein when a pot is in the sleeve the folds expand so that the base substantially covers and surrounds the outer peripheral surface of the pot. The sleeve of Weder et al. would inherently perform the method steps recited in Claim 21. **(Note:** Examiner considers the priority of the present application to extend no farther than to US 6,151,830 (filed 22 April 1998) because in its immediate priority document, US 5,749,171, neither the specification or drawings disclose a sleeve with vertical oriented folds.)

As to Claim 31, Weder et al. disclose a preformed sleeve for covering a pot (Figs. 1-3) having an upper end, lower end, and outer peripheral surface comprising a base portion having an upper end (16 of Fig. 1) and closed lower end (18 of Fig. 1), an interior space when open (see Fig. 2), the base portion initially having a flat

condition prior to being opened (defined as flattening cover on its side, not shown) having a tapered shape when in the flat Condition; and, a plurality of unconnected, vertically oriented, accordion-like, expandable folds (3 Oa-3 Oq of Fig. 2; col. 3 lines 30-35) in the base. **(Note:** Examiner considers the priority of the present application to extend no farther than to US 6,15 1,830 (filed 22 April 1998) because in its immediate priority document, US 5,749,17 1, neither the specification or drawings disclose a sleeve with vertical oriented folds.)

As to Claim 35, Weder et al. disclose a preformed sleeve for covering a pot (Figs. 1-3) having an upper end, lower end, and outer peripheral surface comprising a base portion having an upper end (16 of Fig. 1) and closed lower end (18 of Fig. 1), an interior space when open (see Fig. 2), the base portion initially having a flat condition prior to being opened (defined as flattening cover on its side, not shown) having a tapered shape when in the flat condition; and, a plurality of unconnected, vertically oriented, accordion-like, expandable folds (3 Oa-3 Oq of Fig. 2; col. 3 lines 30-35) in the base. The sleeve of Weder et al. inherently discloses the method steps of Claim 35 when used. **(Note:** Examiner considers the priority of the present application to extend no farther than to US 6,15 1,830 (filed 22 April 1998) because in its immediate priority document, US 5,749,17 1, neither the specification or drawings disclose a sleeve with vertical oriented folds.)

Applicant respectfully traverses the above rejection of pending claims 1, 3-7, 21, 23, 24, 31, 33, and 35.

The present invention as recited in independent claims 1, 21, 31 and 35, and, thus the claims depending therefrom, include a base portion initially constructed to have a flat condition and having a flat condition prior to being opened for receiving the pot into the interior space.

Weder et al. '398 is directed to a flower pot or flower pot cover having a base and a skirt. The base has a plurality of overlapping folds which



extend at various angles and which have different and various lengths. (Col. 1, lines 55-69 and Col. 2, line 1). The flower pot or flower pot cover is formed by disposing a sheet of material between a male and female mold. (Col. 2, lines 11-17).

Weder et al. '398 fails to teach the element of the base portion constructed to have a flat condition and having the flat condition prior to being opened for receiving the pot into the interior space. In fact, the Examiner states in the rejection that the element "defined as flattening cover on its side" is "not shown." Applicant therefore respectfully traverses the rejection of claims 1, 3-7, 10, 21, 23, 24 31, 33, and 35 for the same reasons set forth above in response to the rejection of claims 1, 3-10, 31, and 33 under 35 U.S.C. 102(b) as being anticipated by Olney et al. Such arguments are not repeated here for the sake of brevity but are incorporated herein by reference.

Both case law and the MPEP require that a reference for the purpose of establishing anticipation must set forth each and every element set forth in the claimed invention or provide extrinsic evidence sufficient to establish that one of ordinary skill in the art would understand the characteristic to be inherent. Weder et al. '398 does not disclose an invention having a base portion initially constructed to have a flat condition and having a flat condition prior to being opened. In addition, the Examiner has failed to

provide sufficient evidence to indicate that one of ordinary skill in the art would understand that the cover of Weder et al. '398 could be constructed such that the base portion initially has a flat condition.

Therefore, Applicant respectfully submits that the Examiner reconsider and withdraw the rejection of claims 1, 3-7, 10, 21, 23, 24 31, 33, and 35 under 35 U.S.C. § 102(b) as being anticipated by Weder et al. '398.

Applicant's Response to Examiner's Interpretation  
of the Priority of the Present Application

In the Office Action, the Examiner stated that the priority of the present application extends no farther than to U.S. Patent Number 6,151,830 (filed 22 April 1998). However, Applicant respectfully submits that U.S. Patent No. 5,625,979 (filed 3 May 1994), which is in the related reference daisy chain, and which is explicitly incorporated by reference (see paragraph 0001, last two lines of the specification), shows multiple examples of flat sleeves with vertical, unconnected, expandable folds. See for example Figures 21, 23, 25, 26, 27, 29, 31, and 34. Thus, Applicant respectfully traverses examiner's statement that priority does not extend back to 3 May 1994 and respectfully submits that priority does extend to May 3, 1994, the filing date of U.S. 5,625,979.

Applicant's Response to Claim Rejections

under 35 U.S.C. § 103(a)

In the Office Action, the Examiner also rejected claims 2, 8, 12-17, 19, 20, 22, 32, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Weder et al. (U.S. Patent No. 5,214,398) in view of Landau (U.S. Patent No. 5,235,782). Claims 2, and 8 depend from claim 1, claim 20 depends from claim 12 claim 22 depends from claim 21, claim 32 depends from claim 31 and claim 36 depends from claim 35. In support of such rejections, the Examiner stated that the limitations with regard to independent claims 1, 21, 31, and 36 "are disclosed as described above" with reference to the rejections under 35 U.S.C. § 103(a). In support of the rejection of independent claim 12, the Examiner stated:

As to Claim 12, Weder et al. disclose a preformed sleeve for covering a pot (Figs. 1-3) having an upper end, lower end, and outer peripheral surface comprising a lower portion (region around leadline of 12 of Fig. 1) having an upper end (region around leadline of 10 in Fig. 1), a lower end (region around leadline of 22 in Fig. 1) having a bottom (18 of Fig. 1), an interior space when open (see Fig. 2), the lower portion initially having a flat condition prior to being opened (defined as flattening cover on its side, not shown) having a tapered shape when in the flat condition; an upper portion (14 of Fig. 1) extending from the lower portion; and a plurality of substantially unconnected, vertically oriented, expandable folds (30a-30q of Fig. 2; col. 3 lines 30-35) in the lower portion wherein when a pot is disposed within the interior space of the lower portion the expandable folds expand so that the base substantially covers and surrounds the outer peripheral surface of the pot. Not disclosed is the upper portion detachable from the lower portion by a detaching element. Landau, however, discloses an upper portion (28 of Fig. 1) extending from the lower portion and detachable therefrom via a detaching element (26 of Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the sleeve of Weder et al. by making the upper portion detachable as disclosed by Landau so that the sleeve can be secured on a hanger before use (see Landau at col. 3 lines 28-32) and not have holes in the sleeve when used.

Applicant respectfully traverses the rejections of claims 2, 8, 12-17, 19, 20, 22, 32, and 36 for the reasons set forth herein below.

As discussed above with reference to the rejection of claims 1, 3-7, 10, 21, 23, 24, 31, 33 and 35, the present invention recited in independent claims 1, 12, 21, 31 and 35 and the claims depending therefrom, are directed to a preformed sleeve for covering a pot having, among other elements, a base portion initially constructed to have a flat condition and having a flat condition prior to being opened for receiving the pot into the interior space.

Applicant respectfully submits, as discussed above with reference to the Examiner's rejection of claims 1, 3-7, 10, 21, 23, 24, 31, 33 and 35 under 35 U.S.C. § 102(b) as being anticipated by Weder et al. '398, that Weder et al. '398 does not teach, disclose or suggest a base portion initially having a flat condition prior to being opened for receiving the pot into the interior space. Thus, Applicant respectfully submits that neither Weder et al. '398 nor Landau, taken singly or in combination, teach, disclose or suggest the preformed sleeve for a covering a pot as recited in claims 2, 8, 12-17, 19, 20, 22, 32, and 36.

Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 2, 8, 12-17, 19, 20, 22, 32, and 36 under 35

U.S.C. § 103(a).

**Marked-up Version of Claims**

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made".

## CONCLUSION

This is meant to be a complete response to the Office Action mailed September 27, 2002. Applicant respectfully submits that each and every rejection of pending claims 1, 2, 4-10, 12-24, 31-33, 35, and 36 have been traversed by the remarks provided herewith. Applicant further respectfully submits that such pending claims are now in a condition for allowance and requests issuance of a Notice of Allowance thereof.

Should the Examiner have any questions or comments concerning the before-mentioned amendments to the application or any other matter, Applicant's agent will welcome the opportunity to discuss same with the Examiner.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (Three Times Amended) A preformed sleeve for covering a pot having an upper end, a lower end, and an outer peripheral surface, comprising:

a base portion having an upper end, a closed lower end, and an interior space when opened, the base portion initially

**constructed to have a flat condition and** having **[a] the**

flat condition prior to being opened for receiving the pot into

the interior space and having a tapered shape when in the

flat condition;

a skirt portion extending from the upper end of the base portion;

and

a plurality of substantially unconnected, vertically oriented,

expandable folds in the base portion, and wherein when the

pot is disposed within the interior space of the base portion,

the expandable folds in the base portion expand to cause the

base portion to cover and surround the outer peripheral

surface of the pot.

13.(Three Times Amended) The preformed sleeve of claim 12 wherein the upper portion is further defined as being sized to substantially surround and enclose a floral **grouping** disposed within the pot.

31. (Twice Amended) A preformed sleeve for covering a pot having an upper end, a lower end, and an outer peripheral surface, comprising:

a base portion having an upper end, a closed lower end, and an interior space when opened, the base portion initially **constructed to have a flat condition and** having [a] **the** having a flat condition prior to being opened for receiving the pot into the interior space and having a tapered shape when in the flat condition; and  
a plurality of substantially unconnected, vertically oriented, expandable folds in the base portion.